

## **RESPONSE AND REMARKS**

### *Claim Objections*

The Office Action objected to Claims 1-3, 8, 10 and 23 on various grounds. Office Action, Topic No. 7, pgs. 2-3.

The objections have been carefully considered. It is respectfully asserted that amendments to the objected-to Claims filed concurrently herewith resolve the objections, with the exceptions that objections 7.d and 7.h regarding punctuation and the corresponding suggestion to remove commas. It is respectfully asserted that, as the objections are understood, the present commas reflect a pause in the recitation of the claim language and are not inappropriate.

### *Claim Rejections Under 35 U.S.C. 101*

The Office Action rejected Claims 8-9 under 35 U.S.C. § 101, asserting that "the claimed invention is directed to non-statutory subject matter [and] ... are directed to a graphical symbol for mail pieces, isolated from the system which imparts function to the graphical symbol...." Office Action, Topic No. 8, p. 3.

The rejections under Section 101 have been carefully considered. It is respectfully asserted that amendments to Claims 8 and 9 resolve the rejections under Section 101.

### *Claim Rejections Under 35 U.S.C. 102 (e)*

The Office Action rejected Claims 10-12, 18 and 23 under 35 U.S.C. § 102(e) as being anticipated by Montgomery, et al. (U.S. Application Publication No. 2003/0101143 A1; "Montgomery"). Office Action, Topic No. 9, pgs. 3-6.

### *Claim Rejections Under 35 U.S.C. 103*

The Office Action rejected Claims 21-22 under 35 U.S.C. § 103(a) as being unpatentable over Montgomery. Office Action, Topic No. 11, pgs. 7-8.

The Office Action also rejected Claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Baker, et al., (U.S. Patent Application Publication No. US 2004/0215478 A1, "Baker"). Office Action, Topic No. 12, pgs. 8-9.

The Office Action rejected Claims 1-5, 7-9, and 13-17 under 35 U.S.C. § 103(a) as being unpatentable over Montgomery in view of Baker. Office Action, Topic No. 13, pages 9-18.

The Office Action rejected Claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Montgomery in view of Baker in further view of Denman (U.S. Patent No. 5,737,729; "Denman"). Office Action, Topic No. 14, p.18.

RESPONSIVE REMARKS REGARDING SECTION 102(e) and Section 103(a) REJECTIONS

The rejections of the Claims of the present application under Sections 102(e) and 103(a) have been carefully considered. Claims 1-4, 8-10, 13, 17, 18, and 21-24 have been amended to more distinctly claim the claimed invention; Claims 19-20 have been previously cancelled; new dependent Claim 25 has been added.

For the reasons given below, it is respectfully asserted that none of the references of record disclose, anticipate, teach or suggest all of the limitations of the amended Claims of the present application.

For example, amended Claim 1 recites, among other things:

... receiving, from a postal authority, a plurality of mailing subscriber identifiers assigned by the postal authority to the first class mail piece tracking provider ...

As compared to the above-recited limitations of amended Claim 1, it is respectfully asserted that Baker asserts disclosure of a method for generating a unique tracking number based on PLANET™ and POSTNET codes based on only a *single* PLANET™ subscriber ID. See, e.g., Baker, [0008] ("Specifically, of these 9 or 11 digits, the first five digits is a unique (and *fixed*) 5-digit ID assigned by the United States Postal Service to identify mailers subscribed to the PLANET code service offering." (Emphasis added)); see also, e.g., Baker, [0028].

It is respectfully asserted that the Specification of the present application may be instructive in understanding the distinction between the above-recited limitations of Claim 1 and Baker. First, the Specification of the present application explains that “[t]he CONFIRM® service was designed to serve the high-volume mailer such as telemarketers and other businesses.” Specification, p. 3, lines 3-4. The Specification further explains that “[a]lthough large mailings are not normally the concern of individuals, individuals with low volume mailings could benefit from the ability to track processing and delivery of individual mail pieces. Low volume mailers will not be motivated to pay the high subscription fees for the U.S. Postal CONFIRM® Service. Even if they paid such fees, the CONFIRM® Service does not guarantee tracking of individual mail pieces.” Specification, p. 3, lines 13-18.

Further, the Specification explains, with respect to an exemplary embodiment, that “[t]he exemplary embodiment of the present invention provides a way for low-volume mailers to track individual outbound mail pieces, including tracking of individual U.S. Postal Service FIRST-CLASS MAIL® letters. The exemplary embodiment of the present invention supports tracking of multiple mail pieces mailed by multiple mailers using a single computer-based postage system.” Specification, p. 4, lines 2-6.

The Specification further explains, with respect to an exemplary embodiment, that “... the exemplary mail piece tracking provider is itself a CONFIRM® Service subscriber.” Specification, p. 10, lines 18-19. The specification explains, with respect to an exemplary embodiment, that CONFIRM® Service subscribing the exemplary mail piece tracking provider is a CONFIRM® Service reseller. Specification, p. 6, lines 25-26.

Yet further, the Specification explains, with respect to an exemplary embodiment, that “[a]s a CONFIRM® Service subscriber, the exemplary mail piece tracking provider registers with the U.S. Postal Service to obtain one or more subscriber identifiers (subscriber IDs). ... three (3) exemplary subscriber IDs will be described herein ....” Specification, p. 10, lines 19-23.

Still further, it is respectfully asserted that additional limitations recited by amended Claim 1 further distinguish amended Claim 1 from Baker. For example, amended Claim 1 recites:

identifying from the plurality of mailing subscriber identifiers, a next available mailing subscriber identifier ...

As compared to the above-recited limitations of amended Claim 1, it is respectfully asserted that Baker discloses that the mailing subscriber identifier is fixed. See, e.g., Baker, [0008] ("Specifically, of these 9 or 11 digits, the first five digits is a unique (and *fixed*) 5-digit ID assigned by the United States Postal Service to identify mailers subscribed to the PLANET code service offering." (Emphasis added)); see also, e.g., Baker, [0028].

It is respectfully asserted that amended Claim 1 is further distinguished from the Baker disclosure of a fixed mailing subscriber identifier, in that amended Claim 1 recites:

modifying at least one of the next available mailing subscriber identifier and the next available mailing identifier, until determining a combination of a destination tracking service type, the next available mailing subscriber identifier, the next available mailing identifier, and the delivery address identifier corresponding to the delivery address, that would trackably identify the particular first class mail piece during a particular period of time;

It is respectfully asserted that because Baker considers the mailing subscriber identifier to be fixed that Baker therefore does not disclose, anticipate, teach or suggest the method of modifying, among other things, the next available mailing subscriber identifier until determining a trackable combination.

Yet further, it is respectfully asserted that amended Claim 1 recites limitations that show that various exemplary embodiments of amended Claim 1, for example, would serve a plurality of users, and in particular, a plurality of users of a first class mail piece tracking provider. For example, amended Claim 1 recites:

receiving, from a particular user of the plurality of users of the first class mail piece tracking provider, a request to mail a particular first class mail piece to a delivery address, wherein the request from the particular

user to mail the particular first class mail piece comprises an indication by the particular user to provide tracking of the particular first class mail piece;

As compared to the above-recited limitations of amended Claim 1, it is respectfully asserted that Baker does not disclose serving more than a single user.

It is respectfully asserted that the above-mentioned distinction between amended Claim 1 providing for a plurality of users, and Baker not providing for a plurality of users, is a reflection of the previously mentioned above nature of the first class mail piece tracking provider of various exemplary embodiments of amended Claim 1, acting as a CONFIRM® Service reseller. See, e.g., Specification, p. 6, lines 25-26.

Yet further, it is respectfully asserted that the above-mentioned distinction between amended Claim 1 providing for a plurality of users, and Baker not providing for a plurality of users, is further pronounced by the limitation recited by amended Claim 1 for "...relating the first class mail piece identifier to the particular user of the plurality of users."

In rejecting, among others, Claim 1, the Office Action asserts that Montgomery discloses "... a method for a first class mail piece tracking provider to provide to a plurality of users, tracking of individual outbound first class mail pieces ..." Office Action, Topic No. 13, p. 9.

However, it is respectfully asserted that as compared to Montgomery, various exemplary embodiments of Claim 1, for example, would create and build a new trackable mail piece identifier. As compared to creating and building a new trackable mail piece identifier, it is respectfully asserted that Montgomery discloses generating postage indicia to contain a pre-existing tracking identifier for types of mail for which a tracking identifier exists. For example, Montgomery discloses that "[f]or package mail that contains a unique delivery tracking ID, the ideal unique [tracking ID] character string for the indicium is the tracking ID itself." Montgomery, ¶ [0033].

For types of mail for which a tracking identifier does not exist, Montgomery discloses generating a unique character string for postage indicia. However, Montgomery acknowledges that scanning of postage indicia may only be spot-checked. See, e.g., Montgomery, ¶ [0033].

As compared to a character string that may only be spot checked, amended Claim 1 claims “[a] method for a first class mail piece tracking provider to provide, to a plurality of users, tracking of individual outbound first class mail pieces ....”

Further, it is respectfully asserted that although Montgomery names the character string proposed in Montgomery to be useful in detecting postal fraud a “tracking ID,” Montgomery does not disclose that, other than for package mail that contains a unique delivery tracking ID, that the relevant postal authority would provide tracking feedback for a tracking ID generated by Montgomery. In particular, according to Montgomery, “[i]f the self-validating postage indicia on tracked mail pieces are only spot-checked, the tracking ID obtained from the validated postage indicium can be compared to a standard tracking ID found elsewhere on the mail piece ....” Montgomery, ¶ [0033].

As compared to the character string called a tracking ID in Montgomery, it is respectfully asserted that Claim 1, for example, specifically claims that “...the mailing subscriber identifier correspond[s] to an authorization by the postal authority for tracking first class mailings by the first class mail piece tracking provider ....” As explained in the Specification of the present application, “CONFIRM® service is a product offered by the United States Postal Service.... CONFIRM® is a mail tracking service of PLANET™ Codes that provides electronic tracking information to USPS customers about their First-Class, Standard letter-size, flat mail and periodicals.” Specification, p. 1, line 25 – p. 2, line 1. As compared to the character string called a tracking ID in Montgomery that is only spot-checked to detect fraud, as further explained in the Specification of the present application:

As each mail piece progresses through to its destination, the CONFIRM® barcode on each mail piece is scanned at the different USPS processing

facilities through which it passes. Electronic information for each scan is captured and is sent to a centralized network service, which collects the scan data and packages it for use by USPS customers. The electronic scan information is then electronically transferred from the centralized network and is made available in two ways: through accessing a PLANET™ Codes website or via transmission of electronic files sent to subscribing USPS customers.

Specification, p. 2, lines 18-25.

Accordingly, for the reasons given above, it is respectfully asserted that Montgomery fails to disclose, for example, the method claimed by amended Claim 1 for a first class mail piece tracking provider to provide, to a plurality of users, tracking of individual outbound first class mail pieces using a computer-based postage system.

Yet further, the Office Action asserts that Montgomery discloses "... determining a next available mailing identifier for which a combination of a destination tracking service type, the mailing subscriber identifier, the next available mailing identifier, and the delivery address identifier corresponding to the delivery address, would trackably identify the particular first class mail piece during a particular period of time." Office Action, Topic No. 13, p. 10.

The Office Action asserts, among other things, that the claimed mailing subscriber identifier is a vendor ID. Id. The Office Action asserts that the claimed mailing identifier is a "user account number plus piece count [or ascending register]." Id.

It is respectfully asserted that the various definitions asserted by the Office Action do not consider the disclosure of the Specification of the present application.

To ascertain the meaning of claimed terms, such as, for example, a "mailing subscriber identifier," it is proper to consider the Specification of the present patent application. See, e.g., Markman v. Westview Instruments, Inc., 52 F.3d 967, 979, 34 U.S.P.Q.2D (BNA) 1321, 1329 (Fed. Cir. 1995) (*in banc*), *aff'd*, 517 U.S. 370 (1996) ("To ascertain the meaning of claims, we consider three

sources: The claims, the specification, and the prosecution history.” (citations omitted)).

It is respectfully asserted that, according to the Specification of the present application, the term “mailing subscriber identifier” recited by the Claims is properly interpreted to mean an identifier that corresponds to an authorization by a postal authority for tracking first class mailings. See, e.g., Specification, p. 10, lines 18-25.

In view of the above-described interpretation, it is respectfully asserted that Montgomery fails to disclose the limitations of Claim 1.

Accordingly, for the reasons given and authorities cited above, it is respectfully asserted that Montgomery fails to disclose, for example, the combination of limitations claimed by amended Claim 1.

For the reasons given above, it is therefore respectfully asserted that amended independent Claim 1, and the Claims dependent on it, namely, Claims 2-7 and 25, are patentable over the references of record and are in condition for allowance.

Similar to the above-mentioned distinctions between Claim 1 and the references of record, including Baker and Montgomery, amended independent Claim 8 claims a “...plurality of mailing subscriber identifiers ...,” “...a plurality of users ...,” and “...a first class mail piece tracking identifier ... that is associated with the particular user.” Therefore, for reasons similar to those given above for Claim 1, it is respectfully asserted that amended independent Claim 8, and therefore the Claims dependent on Claim 8, namely Claim 9, are patentable over the references of record and are patentable over the references of record and are in condition for allowance.

Further, similar to the above-mentioned distinctions between Claim 1 and the references of record, including Baker and Montgomery, amended independent Claim 10 claims “... a plurality of users of a computer-based postage provider ...,” and “...saving in a memory storage a relationship between the tracking identifier and the particular user.” Therefore, for reasons similar to those given above for Claim 1, it is respectfully asserted that independent Claim



10 as amended, and therefore the Claims dependent on Claim 10, namely Claims 11-12, are patentable over the references of record and are in condition for allowance.

Yet further, similar to the above-mentioned distinctions between Claim 1 and the references of record, including Baker and Montgomery, amended independent Claim 13 claims a "...formulating a next available first class mail piece identifier for which a combination of a destination tracking service type, a mailing subscriber identifier corresponding to an authorization by a governmental postal authority for tracking first class mailings, the next available first class mail piece identifier, and the delivery address identifier corresponding to the delivery address, would trackably identify the particular first class mail piece during a particular period of time ...." Claim 13 further recites "...storing an association between the particular user and the combination ...." Therefore, for reasons similar to those given above for Claim 1, it is respectfully asserted that independent Claim 13 as amended, and therefore the Claims dependent on Claim 13, namely Claims 14-17, are patentable over the references of record and are in condition for allowance.

Still further, similar to the above-mentioned distinctions between Claim 1 and the references of record, including Baker and Montgomery, amended independent Claim 18 claims "... generating a first class mail piece tracking identifier for the particular first class mail piece, wherein the first class mail piece tracking identifier comprises: a mailing subscriber identifier corresponding to an authorization by a governmental postal authority for tracking first class mailings, a mailing identifier, and a delivery address identifier corresponding to the delivery address, wherein the delivery address is trackably unique within a combination of the subscriber identifier and the mailing identifier during a particular period of time." Claim 18 further recites "... storing a set of information relating the first class mail piece tracking identifier to the particular user ...." Therefore, for reasons similar to those given above for Claim 1, it is respectfully asserted that independent Claim 18 as amended, and therefore the Claims dependent on

Claim 18, namely Claims 21-22, are patentable over the references of record and are in condition for allowance.

Further yet, similar to the above-mentioned distinctions between Claim 1 and the references of record, including Baker and Montgomery, amended independent Claim 23 claims "...a particular first class mail piece identifier that trackably identifies a particular first class mail piece during a particular period of time *and that corresponds to a particular user of a plurality of users of the computer-based postage system ....*" Claim 23 further recites "... reporting to the particular user a set of tracking information associated with the electronic first class mail piece identifier representation." Therefore, for reasons similar to those given above for Claim 1, it is respectfully asserted that independent Claim 23 as amended is patentable over the references of record and is in condition for allowance.

Further still, similar to the above-mentioned distinctions between Claim 1 and the references of record, including Baker and Montgomery, amended independent Claim 24 claims "...assigning a composite confirm identifier to a particular first class mail piece according to input by a particular mailer of a plurality of mailers that use the computer-based postage system, wherein said composite confirm identifier trackably identifies the particular mail piece during a particular period of time ...." Claim 24 further recites "... relating the composite confirm identifier for the particular first class mail piece to the particular mailer ....." Therefore, for reasons similar to those given above for Claim 1, it is respectfully asserted that independent Claim 24 as amended is patentable over the references of record and is in condition for allowance.

#### CONCLUSION

In view of the foregoing amendments, and for the foregoing reasons, it is respectfully submitted that the invention disclosed and claimed in the present application, as amended, is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for

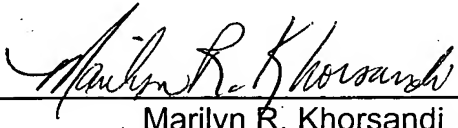
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allowance. Accordingly, reconsideration and allowance of the application as amended herewith is respectfully requested.

Respectfully submitted,

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